

### **REMARKS**

The Office Action mailed February 5, 2004 has been carefully considered. Claims 1-9 are currently pending. Claims 1 and 6 have been amended to more clearly recite the claimed invention. In particular, claim 1 has been amended to recite that the fiber-optic bundle is slidably associated with the catheter lumen. Also, claim 6 has been amended to recite that the fiber-optic bundle is slidably associated with the catheter lumen after the catheter's distal-end sleeve is positioned within the target region and the guidewire is removed. Support for this amendment is found, *inter alia*, in Paragraphs [0021], [0032], and [0037], and Figs. 3C-3D and 6H-6J of the specification of the published application. No new matter has been added by this Amendment.

### **Rejections Under § 103(a)**

Claims 6-9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over United States Patent No. Re. 35,544 to Spears *et al.* ("Spears") in combination with United States Patent No. 5,700,243 to Narciso, Jr. ("Narciso"). This rejection is respectfully traversed.

Spears discloses a method of treating atherosclerosis by utilizing a balloon-type catheter to treat plaques. Spears fails to disclose the apparatus recited in amended claim 6. As the Examiner has repeatedly acknowledged (*see* Office Communication of 10/28/02, pg. 2; Office Communication of 6/23/03, pg. 2), Spears does not disclose a fiber-optic bundle adapted for introduction into a catheter lumen. Moreover, Spears does not disclose or suggest a fiber-optic bundle that is slidably associated with the catheter lumen. Therefore, Spears does not disclose, teach, or suggest the present invention.

Narciso fails to remedy the deficiencies in Spears. As the Examiner acknowledged, Narciso does not teach or suggest the recitation that the optical fibers are removable. Instead, Narciso teaches that the fiber-optic bundle is integral with the catheter (col. 2, lines 14-18). Thus, Narciso does not teach or suggest a fiber-optic bundle adapted for introduction into and slidably associated with a catheter lumen. Therefore, both Spears and Narciso, either singly or in combination, fail to disclose each and every element of amended claim 6. The rejection of claim 6 should be withdrawn. As claims 7-9 depend from independent claim 6, Applicants also request that the rejections of these claims should be withdrawn.

Claims 1 and 3-5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Spears in combination with Narciso. This rejection is respectfully

traversed. The Examiner stated that the rejections of claims 1 and 3-5 were based on the same rationale as the rejections of claims 6-9. Therefore, as both Spears and Narciso, either singly or in combination, fail to disclose every element of claims 6-9, the same is true for claims 1 and 3-5. In particular, claims 1 and 3-5 recite introducing a fiber-optic bundle that is slidably associated with the catheter lumen. As discussed above, Spears and Narciso do not disclose or suggest such features. Therefore, for the reasons discussed above, the rejection of claims 1 and 3-5 should be withdrawn.

Claim 2 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Spears in combination with Narciso, and further in view of United States Patent No. 5,445,608 to Chen *et al.* ("Chen"). This rejection is respectfully traversed.

Chen fails to disclose or suggest an optical fiber separate and insertable into a catheter having a translucent distal-end sleeve after the catheter's distal-end sleeve is positioned with the target region. Instead, Chen discloses at column 19, lines 48-59 that optical fibers are adhesively bonded or heat fused to the light distribution tip at the distal end of the catheter. As discussed above, claim 1 recites that the fiber-optic bundle be separate from and slidably associated with catheter lumen after the catheter's translucent distal-end sleeve is positioned or placed within the target region. By disclosing that the optic fibers are fused to the light distribution tip, i.e., not separate from the catheter, Chen does not disclose these elements of claim 1. Instead, Chen teaches away from the present invention wherein the optic fibers are separate from and slidably associated with the catheter. Therefore, Chen fails to remedy the deficiencies in Spears and Narciso, and therefore does not render claim 2 obvious, as the claim from which it depends (claim 1) is likewise not rendered obvious. The rejection of claim 2 should be withdrawn.

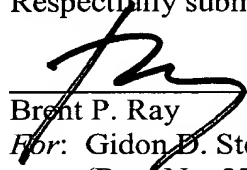
## CONCLUSION

In view of the above amendments and remarks, it is believed that claims 1-9 are in condition for allowance. Should the Examiner not agree with Applicant's position, then a personal or telephonic interview is respectfully requested to discuss any remaining issues and expedite the eventual allowance of the application.

A one-month extension of time fee of \$110 is believed to be due for this response. Should any additional fees be required, please charge such fees to Jones Day deposit account no. 503013.

Respectfully submitted,

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